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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/716,471

11/20/2003

Akemi Sanada

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24956

7590

09/05/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

ADE, OGER GARCIA

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/716,471 | Applicant(s) SANADA ET AL. | |
| | Examiner Garcia Ade | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-38 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 and 39-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This communication is in response to the Election/Restrictions response filed on August 17th, 2006. Applicants elected without traverse, Group II, claims 31 – 38. Claims 1 – 20 are cancelled, claims 21 – 30, and 39 – 43 are withdrawn from consideration.

Double Patenting

2. Claims 31 - 38 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 18 of US Patent 6,868,398. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 31 – 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Crawford [US 6,411,943].

As per claims 31, and 32, Crawford discloses a method for renting and charging for the use of the storage system comprising the steps of: providing the user with an initial volume of storage space of the storage system [see figure 1 (e.g. block 100 program storage, and figure 2 (e.g. block 210)); charging the user for use of the initial volume at a predetermined rate [via Program & Information Rental Services (e.g. block 210), column 15, lines 39 – 44]; providing an added volume of storage space of the storage system as needed by the user [see flowchart of figure 8B (e.g. blocks 456 - 462 provide a generic description of **additional user request handling**)]; charging the user for a portion of the added volume that is actually used by the user [see claim 43 (e.g. **a portion of a mass storage device associated with the customer's computing device to the service provider storage**), column 58, lines 44 – 54 (e.g. **storage usage charges assessed by the security programs into the Billing Data file** by matching Off-line Request begin and ending times)]; wherein the owner of the storage system is notified when the user begins using a portion of the added volume [see section IX (e.g. Request Pending Table Occurs, Request, Date/Time, Estimated Completion, **Notify Method**)].

As per claims 33 and 36, Crawford discloses information about the state of use of the storage system by the user is recorded in a management table [**Storage Charge Table 1010K**], and wherein the state of use information stored in the management table is used in order to determine how much the user is to be

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charged for renting the storage system [see flowchart of figure 10 (e.g. block 504, ***on-line service control data table***)].

As per claims 34 and 38, Crawford discloses the step of: copying data stored in a first portion of the storage system into a second portion of the storage system and charging the user for the use of the second portion of the storage system at a rate lower than for use of the first portion of the storage system [see figure 2 (e.g. block 202, ***virtual disk copy of the customer computer system disk***)].

As per claims 35 and 37, Crawford discloses the steps of: providing a display terminal to the user; and providing a display terminal to the owner; wherein both the user's display terminal and owner's display terminal are connected to the storage system via the internet so that both terminals can receive information regarding the state of use of the storage system by the user [see figure 3 (e.g. block 122, ***local display devices may be connected to host computer 104 to allow local control over the host computer***)].

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571.272.6771. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade
Examiner
Art Unit 3627

ga

Ronald L. Leneau
Primary Examiner

8/31/06